

REMARKS

Applicant has carefully reviewed the Office Action of December 1, 2003 and offers the following remarks to accompany the above amendments. Where appropriate, comments arising from the interview of January 14, 2004 are included.

Before addressing the rejection based on the reference, Applicant provides a brief summary of the present invention so that the remarks are evaluated in the proper context. The present invention is a system designed to allow a user to effectuate caller identification through the use of ring tones. Specifically, instead of referring to a screen to determine the phone number for the originator of the incoming call, the user may associate a particular ring tone with a phone number for the originator of the incoming call. Then, when the user hears that particular ring tone, the user is effectively informed that the incoming call is coming from the phone number so designated. As an example, a user may program the system such that the phone rings "jingle bells" when a call from the user's mother is incoming, and the phone rings "jailhouse rock" when a call from the user's boss is incoming. In a particularly contemplated embodiment, the user creates the association between the ring tone and the caller ID information using a browser that interacts with an application server in the communications network.

Claims 1-3, 6-10, 12-20 and 23-25 were rejected under 35 U.S.C. § 102(e) as being anticipated by Lin et al. Applicant respectfully traverses. For the Patent Office to show anticipation, the reference must show each and every claim element. Further, the elements of the reference must be arranged as claimed. MPEP § 2131. This is a strict standard that has not been met in the present case.

Claim 1 recites "receiving the telephone number of an expected caller . . . [and] associating the telephone number of the expected caller with the audio file . . . ." The Patent Office opines that all the claim elements are shown by Lin et al. at col. 5, lines 3-51. Applicant has read the reference and has carefully studied the cited passage. Applicant respectfully disagrees about the content of this passage.

Lin et al. is directed to a system that allows a user to differentiate calls that come into different phone numbers at a single mobile station. Specifically, Lin et al. contemplates a single mobile station having two B-numbers 90a and 90b. The mobile station rings "tone 1" when a caller dials number 90a and rings "tone 2" when a caller dials number 90b (see col. 5, lines 28-39). Thus, instead of evaluating the telephone number of an expected caller as recited in the

claim, Lin et al. is evaluating the telephone number dialed by the caller. While this distinction is perhaps subtle, it is an important non-obvious distinction and precludes the claim from being anticipated. Further, since Lin et al. is evaluating what number was dialed, not what number the incoming call originated from, Lin et al. does not associate the telephone number of the expected caller with an audio file, reflecting yet another element that the reference does not show. With these distinctions in mind, it is readily apparent that in the Lin et al. system, "tone 1" will ring if the caller dials number 90A regardless of from which phone number the caller dials 90A (e.g., the caller's mother's phone and the boss's phone, if they dial 90A, both ring "tone 1"). In contrast, in the example of the present invention, dialing number 90A from the caller's mother's phone results in "jingle bells" ringing and dialing the same number 90A from the caller's boss's phone will ring "jailhouse rock."

Claims 2, 3, and 6-10 depend from claim 1 and are not anticipated at least for the same reasons. Since the reference does not anticipate the claims, Applicant requests withdrawal of the § 102(e) rejection of claims 1-3 and 6-10 at this time.

Claim 6 deserves special mention in that it recites "receiving a second telephone number of a second expected caller . . . [and] associate[ing] the second telephone number . . . with a second audio file." As explained above, this represents the fact that the incoming calls will be differentiated from one another based on the phone number of the calling party. The Patent Office continues to point to Lin et al., col. 5, lines 3-51 for support for the rejection, but as explained above, Lin et al. differentiates the ring tones based on the number dialed by the caller, not based on the phone number of the caller. To this extent, the reference does not anticipate the claim.

Claim 9 also deserves special mention in that similar to claim 6, claim 9 recites "a profile associating a unique audio file with each of a plurality of telephone numbers of additional expected callers for the telephony device." Again, this claim highlights that the user may have multiple ring tones that provide caller identification based on the different ring tones. Claim 10 depends from claim 9 and also is patentable for this reason.

Claim 12 recites "identifying a telephone number for an originator of an incoming call and selecting an audio file based on the telephone number . . . ." The Patent Office provides no analysis for claim 12, relying on its analysis of the elements for claim 1. As explained above, the present invention evaluates the phone number of the originator, not the phone number that the

originator dialed. No one of ordinary skill in the art would construe the dialed phone number to be the telephone number for an originator of an incoming call as recited in the claim. Thus, Lin et al. does not teach the first element, and because the reference does not teach the first element, cannot then select an audio file based on the telephone number as recited in the claim. Since the reference does not teach the claim elements, the reference cannot anticipate the claim. Claims 13-18 depend from claim 12 and are patentable at least for the same reasons. Applicant requests withdrawal of the § 102(e) rejection of claims 12-18 at this time.

Claim 14 deserves special mention in that it recites "effecting a default ring tone" if the phone number is not associated with an audio file. This element highlights the nature of the caller identification function provided by the present invention. Lin et al. always will provide one of the two tones, neither tone being a default tone. This is because Lin et al. does not provide any caller identification function, but rather merely identifies to which of the B-numbers the incoming call is directed.

Claim 17 recites the profile and is patentable for the additional reasons outlined above with respect to claim 9.

Claim 18 also deserves special mention in that it explicitly recites that the identification of the telephone number is based on caller identification information. Lin et al. does not differentiate incoming calls based on caller identification information, but rather evaluates the B-number dialed by the originator. To this extent, Lin et al. does not show this claim element and cannot anticipate this claim.

Claims 19 and 23 are not separately analyzed by the Patent Office. Claim 19 recites a control system adapted to perform the function recited by the method of claim 1, and claim 23 recites software that does the same. Claims 19 and 23 are patentable at least for the same reasons recited above in Applicant's arguments relating to claim 1.

Claims 20, 24, and 25 are not separately analyzed by the Patent Office. Claim 20 recites a control system adapted to perform the function recited by the method of claim 12, and claim 24 recites software that does the same. Claim 25 is a system claim that invokes the means plus function language form of reciting claim elements, but is functionally substantially similar to claim 12. Claims 20, 24, and 25 are patentable at least for the same reasons recited above in Applicant's arguments relating to claim 12.

During the telephonic interview of 14 January 2004, the Examiner was receptive to the arguments related to the independent claims and opined, without formal commitment, that the claims as presented defined over the Lin reference. However, the Examiner identified three additional references (U.S. Patents 6,375,925; 6,434,934; and 6,466,653) which the Examiner felt were closer to the claimed invention in light of Applicant's explanation. While these references were provided by the Examiner, they were provided during the course of an interview, and, to date, have not been made of record in the application. Applicant has electronically filed an IDS with these references so that the references are entered into the file. If the Examiner has already entered the references, Applicant apologizes for the duplication.

Applicant has reviewed the references and offers the following comments in response thereto. The '653 patent to Hamrick et al. is a system that provides a text-to-speech synthesizer that generates audible caller ID information responsive to an incoming call. Specifically, the caller ID information is sent to the user's telephony device and the caller ID information is manipulated into a form that is suitable for text-to-speech conversion. As such, there are not audible files associated with the expected caller's phone number, and specific audio files are not played based on the incoming caller ID. Rather, the caller ID information is converted contemporaneously with receipt thereof to an audible signal, but there is arguably no audible file disclosed by the reference.

The '394 patent to Grundvig et al. describes a situation where a cordless phone system routes calls to different cordless phones based on the caller ID of the incoming call. At col. 4, lines 49-58, a unique ring signal such as to discriminate between a business call or a personal call can be determined based on the caller ID. It is worth noting that the determination is done within the base station of the cordless phone system (see col. 4, lines 6-10 indicating that the cordless telephone 10 has the association table 26).

The '925 patent to Guercio et al. involves a system where a user may create a stored voice message, typically the name of the calling party, and the stored voice message is played when an incoming call from that individual arrives. The phone makes the determination as to whether there is a stored voice message to be played based on the caller ID. The reference indicates that the stored voice message may be played between rings or in place of the ring tone. The stored voice messages are created at the phone and stored in digital storage unit 36 within

the phone (see Figures 1 and 3). Likewise, the control unit 24 compares the incoming caller ID information and the information in the control memory unit 26 to determine if there is a match.

Applicant herein amends the independent claims to recite that the application server within the communications network is the primary instrument that effectuates the invention. As illustrated in Figure 1, the application server is within the network, and removed from the telephony device. Thus, in contrast to the new references, the claimed invention takes place in the network, not in the telephony device.

Applicant requests reconsideration of the rejection in light of the arguments presented above. Specifically, Lin et al. does not evaluate the incoming caller's telephone number to select the ring tone provided to the user. Applicant further requests consideration of the amended claims relative to the new references. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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